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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MOORE, MARGARET G	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/775,045	Applicant(s) HARWELL ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1 to 20 is/are pending in the application.

4a) Of the above claim(s) 7 to 20 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1 to 6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☑ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1 to 6, drawn to a hot melt adhesive, classified in class 524, subclass 700+.

   II. Claims 7 to 20, drawn to an absorbent article and method of making, classified in class 604, subclass 359.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive in cosmetic formulations or for bonding glass or metal and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Cynthia Foulke and Examiner Michael Bogart on 11/21/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 to 20 have been withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. As a result of applicants' election, this application has been transferred to Examiner Margaret Moore. Attached to this office action is a copy of Examiner Bogart's Interview Summary. The instant examiner has relied upon a different relationship between the two groups in this restriction requirement.

7. Claim 4 contains the trademark/trade name Spicy Oriental Amber Powder (Quest Fragrance Q-26257). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fragrance and, accordingly, the identification/description is indefinite.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Krzysik.

Krzysik teaches sunscreen compositions that contain hot melt silicone pressure sensitive adhesives. See for instance line 15 of column 2. Column 8 teaches the addition of fragrances and perfumes, while lines 59 to 60 specifically teach a composition containing the hot melt pressure sensitive adhesive with .2 to 1.0 wt% of a fragrance. In the absence of any type of indication or suggestion that the fragrance is encapsulated it follows that the fragrance in Krzysik is non-encapsulated. As such these claims are clearly anticipated by the teachings of Krzysik.

10. Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooke et al. or Maleeny et al.

Cooke et al. teach an antipruritic patch which includes a pressure sensitive adhesive. The bottom of column 7 as well as claims 12 and 30, teach hot melt pressure sensitive adhesives. Starting on line 32 of column 9, various fragrances are taught. See also Example 3 which admixes fragrance with an acrylic ester copolymer adhesive. Again, since Cooke et al. are completely silent as to encapsulating the fragrance, this anticipates the instant claims.

Maleeny et al. teach polyurethane/polyurea matrices for the delivery of active agents. The top of column 8 refers to these adhesives as hot melt. Columns 9 and 10 teach various fragrances useful as the active agent and shows working examples that contain a fragrance. This anticipates the instant claims.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 2 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny et al., Cooke et al. or Krzysik.

Maleeny et al. teach on column 9 that "traditional" fragrance agents can be added to this composition and offers specific categories. As admitted by applicants, the fragrance of instant claim 4 is known in the art and is commercially available. While patentees fail to specify a flash point for the fragrance, the teachings in Maleeny et al. embrace such agents. The selection of a particular fragrance will depend upon the final utility of the adhesive composition. One having ordinary skill in the art would have found the selection of a fragrance meeting the limitations of claims 2 to 4 to have been within routine experimentation and/or routine use of the composition in Maleeny et al.

Cooke et al. also fail to specifically teach the limitation of claims 2 to 4. However column 9 lists many operable fragrances and teaches that suitable fragrances are known in the art. Again, in view of the fact that the fragrance of claim 4 is known and commercially available and that the selection of a fragrance will depend upon the utility and artisan's preference, one skilled in the art would have recognized that a fragrance meeting the limitations of claims 2 to 4 would have been an obvious selection as the fragrance in Cooke et al., thereby rendering these claims obvious.

Finally, Krzysik teach that conventional fragrances and perfumes can be used in the sunscreen therein. Obviously, the number of fragrances that can be used therein is quite extensive and the specific selection of a fragrance will depend upon the utility and artisan's preference. Since fragrances meeting the limitations of claims 2 to 4 are known in the art and are commercially available, the skilled artisan would have had a reasonable expectation of success in selecting such a fragrance for the sunscreen

composition therein. In this manner one having ordinary skill in the art would have found these claims to be obvious.

13. Bordoloi et al. and Fiebig, Jr. et al. are cited as being of general interest. Bordoloi et al. is not believed to be any closer to the claims than the prior art cited supra. Fiebig et al. fail to specifically teach that the fragrance containing material is a hot melt adhesive.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
1/31/04